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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,574	12/19/2001	Jack Brass	16224.00046	1008

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EXAMINER

BARTH, VINCENT P

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/021,574

Applicant(s)

BRASS, JACK

Examiner

Vincent P. Barth

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Referring to Claims 16 and 24, both claims indicate that the wavelength is in the range of 385-465 nm, which is generally considered in the visible range by those in the art. Indeed, the blue spectrum is generally defined as ranging from approximately 436 to 500 nm. Thus, the claimed range would be well within the visible range. However, the claims upon each depends indicates that the light is ultra-violet, which is generally defined in the art as approximately 13 to 380 nm. Therefore, it is not entirely clear which meaning should prevail, rendering the claims indefinite. However, the claims have been discussed below as each may best be understood.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in–

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claim 1-14 are rejected under 35 U.S.C. §102(e) as being anticipated by Lebens, et al., U.S. Patent No. 6,305,818 (23 Oct., 2001).

6. Referring to Claim 1, Lebens discloses an LED flashlight, with a plurality of LED's disposed at the opening or head of the flashlight (see Fig. 1), and connected to a power supply 130 providing the LED's with electricity (Fig. 1). As to the use of lighting luminescent material, said purported feature is a non-limiting statement of intended use, which does not distinguish the invention over the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP§2114, citing *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

7. Referring to Claims 2 and 3 Lebens discloses that the LED's may be selected to emit in the ranges of UV, visible, and IR (col. 5, lns. 43-45).

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8. Referring to Claims 4-6, Lebens discloses that the device comprises a housing 110 (Fig. 1), and that the open end has LED's disposed upon a planar substrate, such that the light emits outward. Moreover, said LED's are clearly in array, in which approximately 12 LED's are shown, and in which one would expect to have additional LED's numbering at least 20. See MPEP §2144.04(VI)(B), citing, In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (mere duplication of parts has no patentable significance unless a new and unexpected result is produced.)
9. Referring to Claim 7, Lebens discloses that the voltage is varied in such a manner as to rapidly rise, and thus prevents failure of the LED's (col. 5, lns. 51-55).
10. Referring to Claims 8-11, Lebens discloses that a Fresnel lens may be used to provide a focusable light source (col. 6, ln. 66), and thus focal distances would be varied at the discretion of those practicing the invention. The precise focal distance of 5-10 feet as in Claim 10, is clearly within the normal range of distance one would expect from the disclosure in Lebens. Moreover, removable components such as a lens as in Claim 11 has been well known for some time in the art of flashlight making. See MPEP §2144.03.
11. Referring to Claim 12, Lebens discloses that the casing encloses a battery 120 (col. 7, ln. 42, and Fig. 1).
12. Referring to Claims 13 and 14, and as mentioned above, Lebens discloses that the LED's may be selected to emit in the ranges of UV, visible, and IR (col. 5, lns. 43-45). Therefore, the ranges 200-550 nm and 385-465 nm are included within said range. See MPEP §2131.03 and §2144.05.

*Claim Rejections - 35 USC § 103*

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutbier, U.S. Patent No. 3,808,434 (30 Apr., 1974), in view of Lebens, et al., U.S. Patent No. 6,305,818 (23 Oct., 2001).

15. Referring to Claims 15 and 19 and 21, Gutbier discloses that ultraviolet inspection techniques have been known where a fluorescent penetrating material is applied to a surface, and either surface amounts are removed to reveal defect pattern under UV or other suitable light, or the fluorescent material is applied from the other side to allow for seepage of the material to reveal such defects under the UV light (col. 1, lns. 48-58). However, Gutbier does not explicitly state that the light source should be LED's or the like. The use of LED's represents a non-critical limitation. The Specifications in the instant Application do not disclose why LED's are a critical limitation over the prior art in Gutbier or other similar references. Thus, it appears that the present invention proposed would perform equally well with any light source, as disclosed in the prior art. Accordingly, this feature would have been obvious to those skilled in the art at the time of the invention See MPEP §2144.05(III) and §§716.02-716.02(g) for a discussion of criticality and unexpected results. Notwithstanding this basis of obviousness, Lebens discloses an LED flashlight with a plurality of LED's which emit UV light, and is clearly suitable for such

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use (see Fig. 1). Accordingly, it would have been obvious to those skilled in the art at the time of the invention to use an LED flashlight to emit UV light, if a portable source of illumination were desirable.

16. Referring to Claim 16, Lebens discloses that the LED's may be selected to emit in the ranges of UV, visible, and IR (col. 5, lns. 43-45). Therefore, the ranges 200-550 nm and 385-465 nm are included within said range. See §2144.05.

17. Referring to Claims 17 and 18, Lebens discloses that a Fresnel lens may be used to provide a focusable light source (col. 6, ln. 66).

18. Referring to Claims 20 and 22, Lebens discloses that the LED's may be selected to emit in the ranges of UV, visible, and IR (col. 5, lns. 43-45).

19. Referring to Claim 23, Gutbier discloses that ultraviolet inspection techniques have been known where a fluorescent penetrating material is applied to a surface, and either surface amounts are removed to reveal defect pattern under UV or other suitable light, or the fluorescent material is applied from the other side to allow for seepage of the material to reveal such defects under the UV light (col. 1, lns. 48-58). However, Gutbier does not explicitly state that the light source should be LED's or the like. The use of LED's represents a non-critical limitation. The Specifications in the instant Application do not disclose why LED's are a critical limitation over the prior art in Gutbier or other similar references. Thus, it appears that the present invention proposed would perform equally well with any light source, as disclosed in the prior art.

Accordingly, this feature would have been obvious to those skilled in the art at the time of the invention. See MPEP §2144.05(III) and §§716.02-716.02(g) for a discussion of criticality and unexpected results. Notwithstanding this basis of obviousness, Lebens discloses an LED

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flashlight with a plurality of LED's which emit UV light, and is clearly suitable for such use (see Fig. 1). Accordingly, it would have been obvious to those skilled in the art at the time of the invention to use an LED flashlight to emit UV light, if a portable source of illumination were desirable. Moreover, grouping said components in the form of a "kit" would have been obvious to those skilled in the art at the time of the invention, since those practicing the art, and desiring to carry such items to an inspection site would ordinarily assemble such items in a kit form.

20. Referring to Claim 24, Lebens discloses that the light is in the form of a flashlight (i.e., hand held), and that LED's may be selected to emit in the ranges of UV, visible, and IR (col. 5, lns. 43-45).

#### *Comments*

21. The following patent is also of interest: Lebens, et al., U.S. Pat. No. 6,095,661 (1 Aug., 2000).

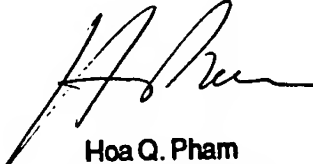
#### *CONCLUSION*

22. Applicants' Claims 1-24 are rejected based on the reasons set forth above.

23. Any inquiries concerning this communication from the examiner should be directed to Vincent P. Barth, whose telephone number is 703-605-0750, and who may be ordinarily reached from 9:00 a.m. to 5:30 p.m., Monday through Friday.

24. If attempts to reach the examiner prove unsuccessful, the examiner's supervisor is Frank G. Font, who may be reached at 703-308-4881.

25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.



Hoa Q. Pham  
Primary Examiner